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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD A. BRACO

Appeal 2008-004362
Application 09/852,119
Technology Center 3600

Decided: September 23, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Ronald A. Braco (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-26 and 31-34. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.¹

THE INVENTION

The invention relates to electronic bill presentment and payment.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A switching system for electronic presentment and payment of bills over a network, comprising:

 a first consumer service provider device which is in electronic communication with a first consumer terminal;

 a first biller service provider device which is in electronic communication with a first biller terminal;

 a second consumer terminal;

 a second biller terminal; and

 a switching network which is in electronic communication with said first consumer service provider device using one of a first message

¹ Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed Jul. 16, 2007) and Reply Brief ("Reply Br.," filed Dec. 18, 2007), and the Examiner's Answer ("Answer," mailed Oct. 19, 2007).

standard protocol and a second message standard protocol, with said first bill service provider device using one of said first and second message standard protocols, with said second consumer terminal using one of said first and second message standard protocols, and with said second biller terminal using one of said first and second message standard protocols, routing presentment information between said first consumer service provider or said second consumer terminal and said first bill service provider or said second biller terminal, said switching network being a multi-standard switch configured to facilitate electronic communication between said first consumer service provider or said second consumer terminal and said first bill service provider and said second biller terminal irrespective of which message standard protocol each of said first consumer service provider, said first bill service provider, said second consumer terminal, and said second biller terminal use.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Hilt	US 5,465,206	Nov. 7, 1995
Kolling	US 5,963,925	Oct. 5, 1999

The following rejections are before us for review:

1. Claims 1-21, 24-26, 31, 32, and 34 are rejected under 35 U.S.C. §102(e) as being anticipated by Kolling.
2. Claims 22, 23, and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kolling and Hilt.

ISSUES

The first issue before us is, whether the Appellant has shown that the Examiner erred in rejecting claims 1-21, 24-26, 31, 32, and 34 under 35 U.S.C. §102(e) as being anticipated by Kolling. Specifically, does Kolling describe a multi standard switch structured to facilitate electronic communication between consumer and biller terminals irrespective of which message standard protocol each of the terminals use?

The second issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 22, 23, and 33 under 35 U.S.C. §103(a) as being unpatentable over Kolling and Hilt. Specifically, does Kolling describe a switching network for routing a payment message for a particular bill irrespective of whether the particular bill has been previously presented to the consumer terminal?

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Kolling

1. Kolling describes an electronic statement presentment system. Col. 1, ll. 12-15.
2. Kolling describes a central site switch 214. Col. 8, ll. 58-59.
3. Kolling is silent as to whether the central site switch is a multi-standard switch.

4. Kolling describes a consumer service provider. Col. 8, ll. 23-26.
5. Kolling is silent as to whether the consumer service provider 134 uses a standard message protocol.
6. Kolling describes a biller service provider 106. Col. 7, ll. 44-46.
7. Kolling is silent as to whether the biller service provider uses a standard message protocol.
8. Kolling does not describe that different financial institutions run different protocols on their networks.
9. As described, the central site switch of Kolling routes payment information from a particular consumer to a particular biller. *See* Col. 9, ll. 14-28.
10. Kolling description of the central site switch routing payment information does not include a consideration of whether or not a particular bill has been previously presented to a consumer terminal when routing a consumer's payment.

Hilt

11. The Examiner cites Hilt to teach the steps of claims 22, 23, and 33, which relate to settlement of the bill. Answer 12-13.

PRINCIPLES OF LAW

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Obviousness

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Graham*, 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1-21, 24-26, 31-32, and 34 under 35 U.S.C. §102(e) as being anticipated by Kolling.

Claims 1-8

In response to the Appellant’s argument that Kolling does not describe that the central switch is a multi-standard switch that facilitates communication between consumer terminals and biller terminals using first and second standard message protocols (App. Br. 10), the Examiner argues that:

[i]t is common sense to note that different financial institutions run[s] different protocols on their networks, and since Kolling can transmit data to any number of statement generated workstations each located in a different consumer's financial institution (CFI), that in and of itself buttresses the point that Kolling is a multi-standard switch which can be configured to communicate using a plurality of different message standard protocols.

Answer 14-15. In the Reply Brief, the Appellant further argues that the Examiner's reliance on common sense in the argument above is an error as claim 1 was rejected as being anticipated by Kolling under §102 and not as obvious under §103. *See* Reply Br. 7.

We agree with the Appellant. First, we note that claim 1 recites, "said switching network *being* a multi-standard switch configured to facilitate electronic communication . . . irrespective of which message standard protocol each of said first consumer service provider, said first bill service provider, said second consumer terminal, and said second biller terminal use." (Emphasis added.) This limitation is drawn to the structure of the switching network as it *is* configured and not as it *can* be configured. The claim 1 requires that the switching network is a multi-standard switch that is structured to facilitate electronic communication irrespective of which of the message standard protocols are used by each terminal.

We find that Kolling does not expressly nor inherently describe that the central site switch 214 is a multi-standard switch having the structure above. Kolling is silent as to whether central site switch 214 is a multi-standard switch as claimed (FF 3) and whether the biller service providers

and consumer service providers are using a first or second standard message protocol (FF 5 and 7). Kolling does not expressly describe this limitation.

The Examiner seems to rely on the theory of inherency to find that the central site switch 214 of Kolling is a multi-standard switch having the structure recited in claim 1. Answer 14-15. Their rationale above is based on the fact that “different financial institutions run[s] different protocols on their networks.” Answer 14. However, this fact is not found in Kolling. FF 4-8. While we agree that it is possible that different financial institutions run different protocols on their network, we do not find that the consumer service provider and the biller service provider of Kolling are necessarily running different protocols on their networks. Inherent anticipation requires that the missing descriptive material is “necessarily present,” not merely probably or possibly present, in the prior art. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed.Cir.1999) (citing *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed.Cir.1991)). *Trintec Industries, Inc V. Top-USA Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002). Further, while it is probable that the central site switch of Kolling would be a multi-standard switch, we do not find that the central site switch necessarily is a multi-standard switch. As noted by the Appellant, the Examiner’s rationale seems more appropriate for a rejection of claim 1 as obvious under §103. Reply Br. 7. If it is necessary to reach beyond the boundaries of a single reference to provide missing disclosure of the claimed invention, the proper ground is not § 102 anticipation, but § 103 obviousness. *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576-77 (Fed. Cir. 1991).

Accordingly, we find that the Appellant has shown that the Examiner erred in rejecting claim 1, and claims 2-8 dependent thereon, under 35 U.S.C. 102(e) as anticipated by Kolling.

Claims 9-16

Unlike claim 1, claim 9 does not recite that the switching network is a multi-standard switching network; however, like claim 1, claim 9 recites that the switching network has a structure that functions to exchange information between consumer terminals and biller terminals, which are using first or second message standard protocols, irrespective of which message protocol each of the terminals use. We find that claim 9 requires that the switching network has a structure that is able to exchange information between the terminals irrespective of which message protocol is used by the terminals.

As, with claim 1, the Appellant again argues that Kolling does not expressly or inherently describe this structure (App. Br. 14), and the Examiner relies upon the same rationale as applied to claim 1 (Answer 18). For the same reasons as above, we find that Kolling does not expressly or inherently, describe a switching network that has the structure above. We find that the Examiner has erred in rejecting claim 9, and claims 10-16 dependent thereon, under 35 U.S.C. 102(e) as anticipated by Kolling.

Claims 17-21 and 24

Like claim 1, claim 17 recites a switching network which is a multi-standard switch which is communicating with biller terminals and consumer terminals using first and second message standard protocols. As, with claim 1, the Appellant again argues that Kolling does not expressly or inherently

describe this limitation (App. Br. 17-19), and the Examiner relies upon the same rationale as applied to claim 1 (Answer 20). Accordingly, because we found the Appellant's argument persuasive as to the rejection of claim 1, we find them equally persuasive as to the rejection of claim 17. We find that the Appellant has shown that the Examiner erred in rejecting claim 17, and claims 18-21 and 24 dependent thereon, under 35 U.S.C. 102(e) as anticipated by Kolling.

Claim 25

Like claim 1, claim 17 recites a switching network which is a multi-standard switch which is communicating with biller terminals and consumer terminals using first and second message standard protocols. As, with claim 1, the Appellant again argues that Kolling does not expressly or inherently describe this limitation (App. Br. 21-22), and the Examiner relies upon the same rationale as applied to claim 1 (Answer 21). Accordingly, because we found the Appellant's argument persuasive as to the rejection of claim 1, we find them equally persuasive as to the rejection of claim 25. We find that the Appellant has shown that the Examiner erred in rejecting claim 25 under 35 U.S.C. 102(e) as anticipated by Kolling.

Claim 26

The Appellant argues that Kolling does not describe that the routing of a payment message is "irrespective of whether the particular bill has been previously presented to the consumer terminal" as recited in claim 26. App. Br. 22 and Reply Br. 10. The Examiner disagrees and points to Kolling's description of routing a payment message (Answer 22), which makes no

mention of considering whether a particular bill has been previously presented to the consumer terminal when routing the payment message.

We agree with the Examiner. First, claim 26 recites a switching network for routing payments irrespective of whether the particular bill has been previously presented to the consumer terminal. This limitation is drawn to the structure of the switching network. The switching network is required to have a structure that routes payments irrespective of whether the particular bill has been previously presented to the consumer terminal. Kolling does describe that the central site switch is structured to the routing of payments. FF 9. In this description, Kolling does not mention that the central site switch takes in to account whether or not a particular bill has been previously presented to a consumer terminal. FF 10. Accordingly, we find that the Appellant has not shown that the Examiner erred in rejecting claim 26 under 35 U.S.C. §102(b) as anticipated by Kolling.

The rejection of claims 22, 23, and 33 under 35 U.S.C. §103(a) as being unpatentable over Kolling and Hilt

The Appellant argues against the rejection of claims 22, 23, and 33 for the same reasons used to argue against the rejection of claims 1 and 17. (App. Br. 24-25). The Examiner's rejection relies upon Hilt to teach the steps of claims 22, 23, and 33, which relate to settlement of the bill and not to teach a multi-standard switch that communicates with consumer and biller terminals using first and second standard message protocols. Answer 12-13. Accordingly, because we the Appellant's arguments persuasive as to the rejections of claims 1 and 17, we find them equally persuasive as to error in the rejection of dependent claims 22, 23, and 33. We find that the Appellant

has shown that the Examiner erred in rejecting claims 22, 23, and 33 under 35 U.S.C. §103(a) as being unpatentable over Kolling and Hilt.

CONCLUSIONS OF LAW

We conclude that the Appellant has shown that the Examiner erred in rejecting:

claims 1-21, 24-25, 31, 32, and 34 under 35 U.S.C. §102(e) as anticipated by Kolling.

claims 22, 23, and 33 under 35 U.S.C. §103(a) as unpatentable over Kolling and Hilt.

We conclude that the Appellant has not shown that the Examiner erred in rejecting claim 26 under 35 U.S.C. § 102(e) as anticipated by Kolling.

DECISION

The decision of the Examiner to reject claims 1-25 and 31-34 is reversed and to reject claim 26 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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REINHART BOERNER VAN DEUREN S.C.
ATTN: LINDA KASULKE, DOCKET COORDINATOR
1000 NORTH WATER STREET, SUITE 2100
MILWAUKEE WI 53202